

## **REMARKS**

Reconsideration of the subject application in view of the present amendment is respectfully requested.

By the present amendment, Claims 1, 5-7, and 9 have been cancelled. Claims 10-11 have been added. Claims 4 and 8 have been amended to provide their proper dependency.

Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance, and action to that end is respectfully requested.

Specifically, Claim 10 recites a stylus in which;

- (i) the breaking point is formed by a circumferential notch; and
- (ii) a shrink sleeve covers at least a section of the stem containing the breaking point.

It is respectfully submitted that the structure recited in Claim 10 is not disclosed or suggested by the prior art, including all of the prior art of record in this application.

Considering the prior art, McMurtry (U.S. Patent No. 4,301,308) does not disclose or suggest that the stylus has a breaking point. Even assuming, *arguendo*, that the spigot (24) can serve as a breaking point, as asserted by the Examiner, the “breaking point” of McMurtry would be different from that according to the present invention.

In view of the above, it is respectfully submitted that McMurtry neither anticipates nor makes obvious the present invention, as defined by Claim 10.

Eitel is not believed to be pertinent to the present invention at all. Eitel relates to the insulated control mechanism and system, in particular, for use with electrically and hydraulically operated equipment, whereas the present invention relates to a stylus for use with coordinate measuring apparatuses or machines. It is further noted that the objects of Eitel are completely different from that of the present invention, namely, preventing from flying around of fragments originated in case of breaking of stylus.

The case law holds that

In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also

*In re Deminski*, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992).

Eitel is not in the field of applicant's endeavor, nor is Eitel pertinent to the problems the present invention is concerned with.

Even assuming *arguendo*, that Eitel is a pertinent reference and McMurtry and Eitel are combined, the combination would still lack an imported feature of the present invention, as set forth in Claim 10 namely, a breaking point formed as circumferential notch. Moreover, the rubber gaiter of McMurtry has to hold oil inside the probe housing. However, the shrink sleeve of Eitel is incapable to perform this function.

Accordingly, it is respectfully submitted that a *prima facie* case of obviousness has not been made.

Under MPEP § 2143 *prima facie* case of obviousness requires that three basic criteria be met.

First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitation.

It is respectfully submitted that the first element of *prima facie* obviousness has not been established.

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggesting supporting the combination. Under section 103, teachings of references can be combined only if there is some suggesting or incentive to do so.”

In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992 (footnote omitted) (emphasis in original). See also In re Sernaker, 217 U.S.P.Q. 1, 6 (Fed. Cir. 1983); SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 8 U.S.P.Q.2d 1468, 1475 (Fed. Cir. 1988); In re Laskowski, 10 U.S.P.Q.2d 1397, 1399 (Fed. Cir. 1989); In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

There is no suggestion, incentive or motivation in McMurtry and/or Eitel for their combination. A statement that it would have been obvious to one skilled in the art to make modifications to the references is not sufficient to establish a *prima facie* case of obviousness. MPEP § 2143.01 relying on Ex Parte Levengood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). In order to establish a *prima facie* case of obviousness, “it is necessary for the Examiner to present evidence, preferably in the form of some teaching, suggesting incentive or inference in the prior art, or in the form of generally available knowledge, that one having ordinary

skill in the art would have been led to combine the relevant teachings.” Id. at 1301 (emphasis in original). No such evidence is presented in the Office Action. It is noted that the case law rejects the “common knowledge” of one skilled in the art as a substitute for specific evidence that the prior art suggests the invalidating combination of references. *In re Lee*, 61 U.S.P.Q. 2d 1430 (Fed. Cir. 2002).

The Federal Circuit has held that a claimed invention was not obvious, where “[c]onspicuously missing from [the] record is any evidence, other than the PTO’s speculation (if it be called evidence) that one skilled in the art would have been motivated to make the modification of the prior art “necessary to arrive at the claimed invention. *In re Jones* 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992).

*Ex Parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App & Inter. 1985) requires that when the references do not suggest the invention “. . . the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teaching of the references.” No such line of reasoning is seen in the Office Action.

Accordingly, it is respectfully submitted that the combination of McMurtry and Eitel would not make the present invention, as defined by Claim 10 obvious, and it is respectfully submitted that Claim 10 is patentable over said combination.

Claims 4 and 8 depend on Claim 10 and are allowable for the same reason Claim 10 is allowable and further because of specific features recited therein which, when taken above and/or in combination with features recited in Claim 10, are not disclosed or suggested in the prior art.

Claim 11 is directed to a coordinate measuring machine in which the stylus of Claim 10 is used, and is allowable for the same reason Claim 10 is allowable.

### **CONCLUSION**

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects, in order to place the case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by Examiner's amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the



Examiner is invited to telephone the undersigned.

Respectfully Submitted,

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